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Attorney's Docket No.: I2010-7058

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert E. Thompson et al.  
Serial No: 10/005,484  
Confirmation No: 8415  
Filed: November 8, 2001  
For: MEDIA CONTROL VALVE  
Examiner: John A. Rivell  
Art Unit: 3753

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the 2<sup>nd</sup> day of November, 2005.

Stephanie Godino

Mail Stop Appeal Brief—Patents  
Commissioner for Patents  
P.O. Box 1450  
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Sir:

Transmitted herewith are the following documents:

- ☒ Applicant's Reply Brief
- ☒ Return Receipt Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch are respectfully requested to contact the undersigned at (617) 395-7000, Cambridge, Massachusetts.

A check is not enclosed. If there is a fee, the Commissioner is hereby authorized to charge Deposit Account No. 50/2762. A duplicate of this sheet is enclosed.

Respectfully submitted,

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Dated: November 2, 2005



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Stephanie Godino

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**APPLICANT'S REPLY BRIEF**

Applicant hereby submits this reply brief, in triplicate, in furtherance of the Notice of Appeal filed on October 26, 2004 in the above-referenced application.

It is believed that no fee is required. Any additional fees that are required for consideration of this paper are authorized to be charged to the deposit account identified on the two copies of the Transmittal of Reply Brief filed herewith.

### **ARGUMENT**

Applicant hereby responds to the Examiner's brief.

#### **Rejections Under § 102(b)**

With respect to the rejections under § 102(b), the Examiner maintains, in the "Response to Argument" portion of his brief, that the valve of Evans meets the limitation "constructed and arranged to provide all metering positions from a fully closed position to a fully open position." As described in detail in the opening brief, this is simply not the case. The valve of Evans is either fully open or fully closed and performs "metering" by a pumping action; there is no provision for that valve to be maintained in intermediate positions.

The Examiner's contention that the Evans valve performs "metering" because "the plunger traverses the entire cross section of the inlet port 97A when moving from its closed position to its open position" is misplaced. The process of opening or closing does not provide for metering as claimed, at least because it does not allow for the plunger to be maintained in an intermediate position.

It is also not the case that an "arrange[ment] to provide all metering positions from a fully closed position to a fully open position" is inherent in the valve of Evans. As described in M.P.E.P § 2131.10, in the passage quoted in the Examiner's brief, evidence of inherency "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference." It is not the case that this feature, as claimed, is "necessarily present" in the valve of Evans. As described in the opening brief, the description of Evans does not include a valve that is "constructed and arranged to provide all metering positions from a fully closed position to a fully open position." Because there is no description or enablement of any embodiment that necessarily includes this feature, there can be no inherency. See Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Education and Research, 346 F.3d 1051 (Fed. Cir. 2003), requiring that "the [prior art] patent must have sufficiently described and enabled at least one embodiment that necessarily featured or resulted in the subject matter embraced by [the] limitation"). The Examiner's assertion that one of skill in the art would recognize that the device of Evans is "capable" of being operated in an incremental fashion finds no support in the reference.

**Rejections Under § 103(a)**

With respect to the rejections under § 103(a), the Examiner maintains that the Shank, Jr. and Schmidt references can be combined to arrive at the claimed invention. The Examiner fails, however, to effectively rebut applicant's arguments.

First, the Examiner again fails to cite any motivation to make this combination and is, instead, using the applicant's disclosure as a guide by which to construct the claimed invention. The Examiner asserts that the Schmidt reference discloses a media valve in which incremental metering is performed, but identifies no actual reason for combining it with Shank, Jr. Essentially, the Examiner has taken the applicant's disclosure and located multiple prior art references that are asserted to include all of the claim limitations and that are then combined without regard to any prior art suggestion to do so. The bare fact that the Schmidt reference teaches metering is not a suggestion to combine it with Shank, Jr. There is no prima facie case of obviousness.

Second, even if properly made, the asserted combination of Shank, Jr. and Schmidt would not contain all of the features of the claimed invention, most notably because the only mechanism for metering disclosed in Schmidt is the threaded shaft 80. Inserting the threaded shaft 80 in the valve of Shank, Jr. as the mechanism for providing incremental metering would necessarily eliminate the claimed plunger and piston.

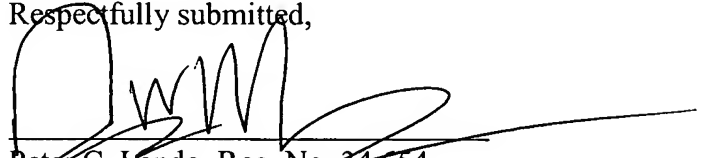
Recognizing this problem, the Examiner departs from the rejections maintained in the Final Office Action and adds an additional feature to the asserted combination, "a threaded shaft from the spring 72 side of the piston to limit the opening stroke of the piston." That addition would not result in a combination that included all of the claim limitations, however, as the device would then be prevented from opening (or closing) past a certain point, meaning that it would not meet the claim limitation "constructed and arranged to provide all metering positions from a fully closed position to a fully open position." At any given time, the device would not be able to fully open (or close).

The Examiner's argument on the issue of a reasonable expectation of success is flawed for the same reasons, as it relies on "a threaded shaft . . . to form an adjustable valve opening

limit stop.” The addition of this feature would mean that not all of the claim limitations would be found in the combination.

For the foregoing reasons, and those contained in the opening brief, Applicant submits that each of the claim rejections was improper and should be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter C. Lando', with a long horizontal flourish extending to the right.

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